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10/560,904	03/06/2006	Ivan Bonzi	4462-22	2362
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EXAMINER				
CADU'GAN, ERICA E				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/560,904

Applicant(s)

BONZI, IVAN

Examiner

Erica E. Cadugan

Art Unit

3726

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 85-169 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 156 and 157 is/are objected to.
- 8) ☒ Claim(s) 85-155 and 158-169 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Election/Restrictions and Claim Objections

Claim Objections

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 86-170 have been renumbered as claims 85-169. (Note that any future amendments to the claims need to take this into account, both for the numbers of the claims themselves, as well as with respect to the dependencies of the various dependent claims).

2. Claims 156 and 157 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim must refer to other claims in the alternative only. See MPEP § 608.01(n). Accordingly, the claims 156 and 157 have not been further treated on the merits.

Election/Restrictions

3. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 85-93, 94-115, and 116-122, drawn to a “device for positioning a tool”.

Group II, claim(s) 123-126, 158-169, drawn to an “apparatus for the production of caps”.

Group III, claim(s) 127-131, drawn to an “apparatus for the production of caps”.

Group IV, claim(s) 132-140, drawn to an “apparatus for the production of caps”.

Group V, claim(s) 141-144, drawn to an “apparatus for the production of caps”.

Group VI, claim(s) 145-153, drawn to an “apparatus for the production of caps”.

Group VII, claim(s) 154-155, drawn to an “apparatus for the production of caps”.

It is noted that within the various groups that there are also a large number of species and/or subspecies of invention, which will also be addressed below.

4. Firstly, comparing group I (directed to a “device for positioning a tool”) to groups II through VII (directed to an “apparatus for the production of caps”):

The invention listed as Group I as compared to Groups II-VII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Group I lacks unity of invention with Groups II-VII *a priori*, noting the lack of any same or corresponding features at all between Group I and Groups II-VII, as evidenced by a comparison of independent claims 85 and 94 with independent claims 123, 127, 132, 141, 145, and 154.

5. Secondly, regarding a comparison of the claims of Groups II to those of Groups III-VII:

the inventions listed as Groups II and III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

in accordance with the guidance set forth in MPEP section 1850, it has been determined *a posteriori*, i.e., after taking the prior art into consideration, that the features common to independent claims 123 and 127 of Groups II and III, respectively, do not constitute “special

technical features” since they do not make a “contribution” over the prior art in light of at least U.S. Pat. No. 5,488,888 to Kowal, for example.

Re Group II and Group III, the features in common between independent claims 123 and 127 are as follows: an “apparatus for the production of caps, comprising a first operating turntable device associated with a first operating arrangement and a further operating turntable device associated with a further operating arrangement”.

Note that Kowal teaches an apparatus for the production of “caps” 20 (shown in Figures 1, 4, for example), which apparatus includes a “first operating turntable device” in the form of starwheel 57 having a “first operating arrangement”, such as, for example, the drive for feeding the starwheel 57 (see Figure 10 and col. 3, lines 26-27, noting that if there was no such drive, the starwheel could not function to feed as described). Additionally, there is a “further operating turntable”, such as either one of turret 51 or starwheel 58 (see Figure 10 and at least col. 3, lines 14-18 and 26-27), and a “further operating arrangement” that is “associated” therewith, such as, for example, the drive for the starwheel 58 (which must be present for the starwheel to function as described in col. 3, lines 26-27), the drive for rotating the turret 51, or the knives 35, for example.

The inventions listed as Groups II and IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Groups II and IV lack any corresponding special technical features *a priori* as evidenced by a comparison of independent claims 123 and 132. Note that the only common feature between claims 123 and 132 is the

limitation “apparatus for the production of caps”, which feature is clearly not a feature that defines over the prior art, and which feature is thus clearly not a special technical feature.

The inventions listed as Groups II and V do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Groups II and V lack any corresponding special technical features *a priori* as evidenced by a comparison of independent claim 123 and 141. Note that the only common feature between claims 123 and 141 is the limitation “apparatus for the production of caps”, which feature is clearly not a feature that defines over the prior art, and which feature is thus clearly not a special technical feature.

The inventions listed as Groups II and VI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Groups II and V lack any corresponding special technical features *a priori* as evidenced by a comparison of independent claim 123 and 145. Note that the only common feature between claims 123 and 145 is the limitation “apparatus for the production of caps”, which feature is clearly not a feature that defines over the prior art, and which feature is thus clearly not a special technical feature.

The inventions listed as Groups II and VII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Groups II and VII lack any corresponding special technical features *a priori* as evidenced by a comparison of independent claim 123 and 154. Note that the only common feature between claims 123 and 154 is the

limitation “apparatus for the production of caps”, which feature is clearly not a feature that defines over the prior art, and which feature is thus clearly not a special technical feature.

6. Thirdly, regarding a comparison of the claims of Groups III to those of Groups IV-VII:

Re Groups III and IV, III and V, III and VI, and III and VII, the inventions listed as Groups III and IV, III and V, III and VI, and III and VII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:.

These groups lack any corresponding special technical features *a priori* as evidenced by a comparison of independent claims 127 and 132, 127 and 141, 127 and 145, and 127 and 154. Note that the only common feature between claims 127 and each of claims 132, 141, 145, and 154 is the limitation “apparatus for the production of caps”, which feature is clearly not a feature that defines over the prior art, and which feature is thus clearly not a special technical feature.

7. Additionally, regarding a comparison of the claims of Groups IV to those of Groups V-VII:

Re Groups IV and V, IV and VI, and IV and VII, the inventions listed as Groups IV and V, IV and VI, and IV and VII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:.

These groups lack any corresponding special technical features *a priori* as evidenced by a comparison of independent claims 132 and 141, 132 and 145, and 132 and 154. Note that the only common feature between claims 132 and each of claims 141, 145, and 154 is the limitation

“apparatus for the production of caps”, which feature is clearly not a feature that defines over the prior art, and which feature is thus clearly not a special technical feature.

8. Additionally, regarding a comparison of the claims of Groups V to those of Groups VI-VII:

Re Groups V and VI, and V and VII, the inventions listed as Groups V and VI, and V and VII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Groups V and VI lack any corresponding special technical features *a priori* as evidenced by a comparison of independent claims 141 and 145. Note that the only common feature between claims 141 and 145 is the limitation “apparatus for the production of caps”, which feature is clearly not a feature that defines over the prior art, and which feature is thus clearly not a special technical feature.

Re Groups V and VII, in accordance with the guidance set forth in MPEP section 1850, it has been determined *a posteriori*, i.e., after taking the prior art into consideration, that the features common to independent claims 141 and 154 of Groups V and VII, respectively, do not constitute “special technical features” since they do not make a “contribution” over the prior art in light of at least U.S. Pat. No. 5,488,888 to Kowal, for example.

Re Group V and Group VII, the features in common between independent claims 141 and 154 are as follows: an “apparatus for the production of caps”, and a “cutting arrangement arranged to make on said caps a nominal cutting line”.

Note that Kowal teaches an apparatus for the production of “caps” 20 (shown in Figures 1, 4, for example), which apparatus includes a “cutting arrangement” including cutting knives 35, 40, “arranged to make on said cap” 20 a “nominal cutting line” (see Figures 10 and 8 and at least col. 2, lines 49-65, for example).

9. Additionally, regarding a comparison of Group VI to Groups VII:

Re Groups VI and VII, in accordance with the guidance set forth in MPEP section 1850, it has been determined *a posteriori*, i.e., after taking the prior art into consideration, that the features common to independent claims 145 and 154 of Groups VI and VII, respectively, do not constitute “special technical features” since they do not make a “contribution” over the prior art in light of at least EP 1243520 (hereinafter EP ‘520).

Re Group VI and Group VII, the features in common between independent claims 145 and 154 are as follows: an “apparatus for the production of caps comprising a folding arrangement arranged to fold a fixing promoting arrangement” of the caps”. EP ‘520 teaches an arrangement for producing a closure cap that includes a folding unit; as evidenced by the English language abstract from the DERWENT database of the EP ‘520 reference, for example.

10. Additionally, this application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

11. The species are as follows:

- a. Within Group I, there is a first species shown in Figures 3-6, a second species shown in Figures 7-12, a third species shown in Figure 17, a fourth not-shown species (described on page 28 of the marked-up copy of the substitute specification filed

5/7/2009 and set forth in at least claim 120) including a detecting arrangement that comprises a "temperature sensor arranged to detect the temperature of said object", and a fifth not-shown species (described on the same page 28 and set forth in at least claim 121) including a detecting arrangement that comprises a "colour sensor device arranged to detect the colour of said object".

The species listed above within Group I do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons:

In accordance with the guidance set forth in MPEP section 1850, it has been determined *a posteriori*, i.e., after taking the prior art into consideration, that the features common to all the claims in Group I, i.e., the features of independent claim 94, do not constitute "special technical features" since they do not make a "contribution" over the prior art in light of at least U.S. Pat. No. 3,762,247 to Sherwood et al., for example. Specifically note that Sherwood teaches a device for positioning a cutting tool T in relation to an object or workpiece (to be held in workpiece spindle 14). The device includes a "toolholder element", such as, for example, carriage 22 on which tool T is ultimately held. "Abutting member" 82 (or 84, for example) serve to "tighten" the "toolholder element" 22 against an "adjustable member" 60 (or 62, for example). See Figures 3-7 and at least col. 3, lines 1-55, and particularly lines 38-52, for example.

b. Additionally, within Group II, there is a first species, shown in Figure 15, and a second species, shown in Figures 18-21.

The species listed above within Group II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons:

In accordance with the guidance set forth in MPEP section 1850, it has been determined *a posteriori*, i.e., after taking the prior art into consideration, that the features common to all the claims in Group II, i.e., the features of independent claim 123, do not constitute “special technical features” since they do not make a “contribution” over the prior art in light of at least U.S. Pat. No. 5,488,888 to Kowal, for example. Specifically note that Kowal teaches an apparatus for the production of “caps” 20 (shown in Figures 1, 4, for example), which apparatus includes a “first operating turntable device” in the form of starwheel 57 having a “first operating arrangement”, such as, for example, the drive for feeding the starwheel 57 (see Figure 10 and col. 3, lines 26-27, noting that if there was no such drive, the starwheel could not function to feed as described). Additionally, there is a “further operating turntable”, such as starwheel 58 (see Figure 10 and at least col. 3, lines 14-18 and 26-27), and a “further operating arrangement” that is “associated” therewith, such as, for example, the drive for the starwheel 58 (which must be present for the starwheel to function as described in col. 3, lines 26-27). Additionally, between the first 57 and second 58 operating turntable devices, there is interposed a “transferring turntable device” in the form of overall turret 51 (shown in Figures 10 and 11), which serves to transfer the caps 20 between the “first” 57 operating turntable device and the “second” 58 operating turntable device (see Figures 10 and 11, for example).

c. Additionally, within Group IV, there is a first species, shown in Figure 16, wherein there is a chamber associated with the transferring turntable 6, a second not-shown species wherein there is an "adjusting arrangement...arranged to adjust the temperature inside the chamber"; a third not-shown species wherein there is "an irradiating arrangement...arranged to irradiate said caps"; a fourth not-shown species wherein there is a "cleaning arrangement...arranged to clean said caps", a fifth not-shown species wherein the chamber is associated with the further transferring turntable 7.

The species listed above within Group IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons:

In accordance with the guidance set forth in MPEP section 1850, it has been determined *a posteriori*, i.e., after taking the prior art into consideration, that the features common to all the claims in Group IV, i.e., the features of independent claim 132, do not constitute "special technical features" since they do not make a "contribution" over the prior art in light of at least U.S. Pat. No. 5,488,888 to Kowal, for example. Specifically note that Kowal teaches an apparatus for the production of caps, which apparatus includes a cutting arrangement with blades 35, 40. While Kowal does not explicitly teach a "chamber isolated from an external environment", it is noted that while the caps are located in the machine taught by Kowal, they are subjected to "controlled treatments", as broadly claimed, noting the automation of the cutting "treatment" of the caps in Kowal's machine. However, Examiner takes Official Notice that it is well known in the manufacturing art to provide manufacturing equipment, and particularly cutting devices

with sharp blades that could be dangerous to an operator, within a guarding device or enclosure chamber for the purpose of protecting the operator of the manufacturing equipment. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided Kowal's device within a well-known enclosure or chamber for the purpose of protecting an operator outside the chamber from the manufacturing operation occurring within the chamber.

d. Additionally, within Group V, there is a first species, shown in Figure 17, wherein there is a position sensor 63 arranged to detect a position of the cutting arrangement 23; a second, not-shown species, wherein the sensing arrangement includes a "temperature sensor arranged to detect the temperature of said caps"; and a third not-shown species, wherein the sensing arrangement includes a "colour sensor arranged to detect the colour of said caps".

The species listed above within Group V do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons:

In accordance with the guidance set forth in MPEP section 1850, it has been determined *a posteriori*, i.e., after taking the prior art into consideration, that the features common to all the claims in Group V, i.e., the features of independent claim 141, do not constitute "special technical features" since they do not make a "contribution" over the prior art in light of at least U.S. Pat. No. 5,488,888 to Kowal, for example. Specifically note that Kowal teaches an apparatus for the production of caps 20, including a cutting arrangement (with blades 35, 40) that makes a "nominal cutting line" on the caps 20 (at

least Figure 10). While Kowal does not explicitly teach the use of a sensing arrangement that monitors the position of the cutting arrangement, Examiner takes Official Notice that the use of a sensor of some sort to monitor the position of a cutting tool in a cutting operation is well-known and widely used in the cutting arts for the purpose of ensuring that a quality and accurate cut is being made by the cutting tool. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided a generic “sensor” that monitors the positioning of the cutting arrangement in relation to the caps, for the purpose of increasing the quality of the caps 20 produced by increasing the accuracy of the cutting operation performed by blades 35, 40.

12. Thus, should Applicant elect any of Groups I, II, IV, or V listed above, Applicant is required, in reply to this action, to elect a single species (as outlined above) to which the claims shall be restricted if no generic claim is finally held to be allowable. **The reply must also identify the claims readable on the elected species, including any claims subsequently added.** An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erica E. Cadugan whose telephone number is (571) 272-4474. The examiner can normally be reached on Monday-Thursday, 5:30 a.m. to 4:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David P. Bryant can be reached on (571) 272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Erica E Cadugan/
Primary Examiner
Art Unit 3726

eec
March 11, 2010